

REMARKS

Claims 1 through 6 are pending in this Application. Applicants acknowledge, with appreciation, the Examiner's allowance of claims 2 and 3. Accordingly, the only remaining issue pivots about the patentability of claims 1, 4, 5 and 6.

Claims 1, 5 and 6 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicants submit that the present Amendment does not generate any new matter issue.

Claims 5 and 6 were rejected under the second paragraph of 35 U.S.C. § 112.

Claims 5 and 6 were also rejected under 35 U.S.C. § 101.

In rejecting claims 5 and 6 under the second paragraph of 35 U.S.C. § 112 and under 35 U.S.C. § 101, the Examiner asserted that the claims encompass two different statutory classes of invention. These rejections are traversed.

In response, claims 5 and 6 have been amended to clarify that a method is being claimed. Claims 5 and 6 refer to an optical communication system in order to give meaning to the subsequently recited method steps and to provide antecedent basis. It is inconceivable that one having ordinary skill in the art would not have understood that claims 5 and 6 are directed to a method, noting the language "A method of assigning ... said method comprising the steps of ...".

Based on the foregoing, Applicants submit that the imposed rejections of claims 5 and 6 under the second paragraph of 35 U.S.C. § 112 and under 35 U.S.C. § 101 are not legally viable and, hence, solicit withdrawal thereof.

Claims 1, 4 and 5 were rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones et al.

In the statement of the rejection the Examiner asserted that Jones et al. disclose a system and method corresponding to those claimed referring, *inter alia*, to Fig. 5 of Jones et al., column 5 lines 22 through 24. This rejection is traversed.

Applicants would again stress that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a fundamental difference between the claimed optical communications system and method, particularly as now amended, and those of Jones et al. that scotch the factual determination that Jones et al. disclose an optical communication system and method identically corresponding to those claimed.

Specifically, each of independent claims 1 and 5 specify that each of the nodes adds the signals of the selected channel to the transmission line **without compensating for the signals**. This feature is neither disclosed nor suggested by Jones et al.

Applicants would note that the Examiner's interpretation of Jones et al. is factually inaccurate. Specifically, on page 6 of the February 7, 2005 Office Action, first paragraph, the Examiner asserts:

Referring to Figure 5, Jones et al teaches wherein each of said nodes has no additional chromatic dispersion compensator in an optical path (22) from the transmitter (26) thereof to the optical transmission line (12) (col. 5, lines 22-24).

The above quoted determination is not accurate. As one having ordinary skill in the art would have clearly understood from column 5, lines 22-24, the optical path (22) of Fig. 5 **directly compensates** the signals from the transmitter (26). Moreover, as apparent from (c) of Fig. 2, the compensation of the optical path (22) is carried out by occurring a positive chromatic dispersion therein. **Accordingly, it is perfectly clear that the optical path (22) itself functions as a chromatic dispersion compensator.**

In contradistinction to the teachings of Jones et al., in accordance with the present invention, each of the nodes includes a transmitter and adds the signals of the assigned signal channel to the transmission line **without compensating for the signals from the transmitter.** Clearly, this means that each of the claimed nodes has **no compensator or compensating fiber**, such as in Jones et al., i.e., fiber (22).

Moreover, as apparent from column 3, lines 10 through 14, Jones et al. are **not** referring to a selection of signal channel to be added to the transmission line. Jones et al. merely teach that a chromatic dispersion of each signal to be added is adjusted such that a dispersion at the end of the system becomes minimum. Moreover, the selection of the shortest wavelength or the longest wavelength is carried out for determining the signal channel to be **dropped**. Therefore, the Examiner's interpretation of Jones et al. appearing at page 4 of the February 7, 2005 Office Action, lines 7 through 13, is inaccurate.

Based upon the foregoing it should be apparent that the claimed optical communication system and method are clearly different from those of Jones et al. Moreover, the Examiner's interpretation of Jones et al. is inaccurate as discussed *supra*.

The above argued **differences** between the claimed optical communication system and method vis-à-vis the optical communication system and method of Jones et al. undermine the

factual determination that Jones et al. disclose an optical communication system and method identically corresponding to those claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of claims 1, 4 and 5 under 35 U.S.C. § 102 for lack of novelty as evidenced by Jones et al. is not factually viable and, hence, solicit withdrawal thereof.

Applicants again acknowledge, with appreciation, the Examiner's allowance of claims 2 and 3. Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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